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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,828	11/09/2004	Koichi Nishimura	2593-0148PUS1	3768
2292 7590 10/19/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER SHAHER, RICKY D	
			ART UNIT 2872	PAPER NUMBER
			NOTIFICATION DATE 10/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/508,828

Applicant(s)

NISHIMURA, KOICHI

Examiner

Ricky D. Shafer

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2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 08/02/207 have been fully considered but they are not persuasive.

Applicant argues that support for the optical film being measured at 5 points at regular intervals over 490 mm in the width direction can be found on page 29, lines 2-8 of the specification, based on the conclusion that 490 mm was calculated by a formula $490 \text{ mm} = 550 \text{ mm (width of the thermoplastic film) - 30 mm (removed parts as selvage) } \times 2$.

The examiner disagrees and is of the opinion that applicant's disclosure found on page 29, lines 2-8 of the specification does not support applicant's conclusion. In fact, the 30 mm that was removed as selvage from both ends by a cutter could have been very well removed from the length of the optical film and not the width, as proclaimed by applicant.

According, the rejection of the claims under 35 U.S.C. 112, first paragraph is repeated.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 10-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the optical film being measured at 5 points at regular intervals over 490 mm in the width direction, as is now claimed. See page 23, lines 8-22.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahiko ('221).

To the extent the claims are supported by the original specification, Takahiko discloses an optical film composed of a thermoplastic resin film having an alicyclic structure (see paragraphs 006 and 007 and examples 1-3 in paragraph 0024) obtained by using a melt extruding machine (see paragraphs 0016-0017), characterized in that said thermoplastic resin film satisfies a relation of the formula recited by applicant over the whole surface of the film (see paragraphs 004, 006, 0012 and examples 1-3 in paragraph 0024) when an angle made by the extruding direction of the thermoplastic resin film from the melt extruding machine and a slow phase axis at each point is α , and a retardation amount at each point is Re (see examples 1-4 in paragraph 0024) and wherein the optical film is a protective film of a polarizer and the protective film is provided on one surface or both surfaces of the polarizer (see paragraph 0013) via an adhesive layer (see paragraph 0023) and wherein the optical film provides for a phase difference obtained by performing a stretch processing on the optical film (see paragraphs 0008-0011 and examples 1-4 in paragraph 0024), except for explicitly stating that the Re value for the alicyclic structure is less than 2 nm.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the alicyclic structure of Takahiko to have a Re value less than 2 nm, due to

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the fact that Takahiko clearly teaches that it is known to process thermoplastic resin films having a Re value less than 2 nm (see example 4 in paragraph 0024), in order to meet end user specifications, since it has been held that discovering an optimum value/workable ranges involves only routine skill in the art. Note In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and In re Aller, 105 USPQ 233.

As to the “product by process” limitations recited in claim 1, “product by process” limitations in a claim drawn to structure are directed to the product per se, no matter how actually made, see In re Thorpe, 227 U.S.P.Q 964, which makes clear that it is the patentability of the final product per se which must be determined in claims having “product by process” limitations, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product whether claimed in “product by process” claims or not. Note : Applicant has the burden of proof in such cases, as the above case law makes clear. In the instant case, applicant must prove that the optical film of Takahiko, by material evidence (such as detail calculations and/or affidavits) that the optical film do not necessarily or inherently processes the characteristics expressed by applicant’s claimed product (formula).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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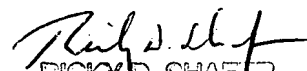
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDS

October 14, 2007


RICKY D. SHAFER
PATENT EXAMINER
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